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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/748,888	12/27/2000	David P. Greene	YOR9-2000-0304 (1963-5006)	5706
28062	7590	04/08/2004	EXAMINER	
BUCKLEY, MASCHOFF, TALWALKAR LLC 5 ELM STREET NEW CANAAN, CT 06840			MOONEYHAM, JANICE A	
			ART UNIT	PAPER NUMBER
			3629	

DATE MAILED: 04/08/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/748,888

Applicant(s)

GREENE ET AL.

Examiner

Jan Mooneyham

Art Unit

3629

Mh

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 December 2000.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-27 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-27 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

1. This is in response to the communication filed on December 27, 2000. Claims 1-27 are currently pending in this application.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 1-27 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In Claims 1, 10 and 19, the applicant states that matching of contrasting risk profiles is performed. What does the applicant mean by the terms “matching” and “contrasting”? How are contrasting risk profiles determined? How are they matched? What is a risk event? It has not been defined.

In Claims 3, 12 and 21, the applicant states that the risk aggregator service serves as a party in the transaction. The applicant has not identified any other parties. What transaction?

In Claims 2, 5, 11, 14, 20 and 24, how is a risk reducing contract facilitated? What is a risk reducing contract? This has not been defined.

In Claims 7, 16, and 25, what does the applicant mean by facilitating the exchange of assets? How was the agreement reached? What does the applicant mean by the language “as determined by the outcome of the risk event?”

Claims 9, 18 and 27 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which

Art Unit: 3629

applicant regards as the invention. What does the applicant mean by a designation of the risk event? The applicant has the risk profile containing a risk profile. Where does the user's desired risk limiting value come from? What various risk events?

Claims 10-18 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. What does the applicant mean by "a system" and "a device?"

Claims 19-27 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. What is a machine readable device? What is a "code?"

3. Claims 3, 12, and 21 recite the limitations "the risk aggregator" and "the transaction."

There is insufficient antecedent basis for this limitation in the claim.

4. Claims 4, 13 and 22 recite the limitations "the users" and "the risk aggregation service"

There is insufficient antecedent basis for this limitation in the claim.

5. Claims 7, 16, and 25 recite the limitation "the risk event." There is insufficient antecedent basis for this limitation in the claim.

6. The term "contrasting" in claims 1, 10, and 19 is a relative term which renders the claim indefinite. The term "contrasting" is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention.

7. Regarding claims 8, 17 and 26, the phrase "can be" renders the claim(s) indefinite because the claim(s) include(s) elements not actually disclosed (those encompassed by "or the like", thereby rendering the scope of the claim(s) unascertainable. See MPEP § 2173.05(d).

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

8. Claims 1-9 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

The basis of this rejection is set forth in a two-prong test of:

- (1) whether the invention is within the technological arts; and
- (2) whether the invention produces a useful, concrete, and tangible result.

For a claimed invention to be statutory, the claimed invention must be within the technological arts. Mere ideas in the abstract (i.e., abstract idea, law of nature, natural phenomena) that do not apply, involve, use, or advance the technological arts fail to promote the "progress of science and the useful arts" (i.e., the physical sciences as opposed to social sciences, for example) and therefore are found to be non-statutory subject matter. For a process claim to pass muster, the recited process must somehow apply, involve, use, or advance the technological arts.

In the present case, claims 1-9 only recite an abstract idea. The recited steps of merely receiving a profile, storing the profile and matching profiles does not apply, involve, use, or advance the technological arts since all of the recited steps can be performed in the mind of the user or by use of a pencil and paper. These steps only constitute an idea. The invention in the body of the claims must recite technology.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

9. Claims 1-27 are rejected under 35 U.S.C. 102(b) as being anticipated by King et al (US 5,704, 045) (hereinafter referred to as King..

Regarding Claims 1, 10 and 19:

King discloses method, system and medium for implementing a risk aggregation service comprising:

receiving risk profiles from users (Fig. 1);

storing the risk profiles (Fig. 1);

matching contrasting risk profiles (Fig. 1).

Regarding Claims 2, 11 and 20:

King discloses facilitating a risk reducing contract between users (Fig. 2-6, col. 4, lines 11-17, 31-34)

Regarding Claims 3, 12 and 21:

King discloses the risk aggregator service serving as a party (Fig. 1-6)

Regarding Claims 4, 13, and 22:

King discloses an interaction between users over a network (Figs. 1-6)

Regarding Claims 5, 6, 14, 15, 23 and 24:

The fact that the risk reducing contract includes incorporation of actuarial data is non-functional descriptive material. This language is not functionally interrelated with the acts, structure or properties of the claimed invention and thus will not serve as a limitation. See *in re Gulack*, 217 USPQ 401 (CAFC 1983), *Ex parte Carver*, 227 USPQ 465 (BdPatApp&Int 1985), and *In re Lowery*, 32 USPQ2d 1031 (CAFC 1994).

Regarding Claims 7, 16, and 25:

King discloses ascertaining the outcome of a risk event; and facilitating the exchange of assets (col. 2, lines 20-29)

Regarding Claims 8, 17, and 26:

King discloses a risk event (col. 5, 45-55, col. 6, lines 39-43)

Regarding Claims 9, 18, and 27:

King discloses a risk profile containing a user identifier (Figs. 1-6)

Conclusion

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Silverman et al discloses a negotiated matching system with respective counter parties that are mutually acceptable.

Haught et al discloses a system and method for obtaining data from vendors and rendering risk evaluative decisions.

Turberville et al discloses a risk management and risk transfer conduit system (Figs. 3 and 4).

WO 02/25404 discloses an impartial forum operable to match investors and service providers.

Hodgkinson, Luke and Walker, Ellen discloses an expert system for credit evaluation.


Art Unit: 3629

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jan Mooneyham whose telephone number is (703) 305-8554. The examiner can normally be reached on Monday through Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss can be reached on (703) 308-2702. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

JM



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